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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,527	12/08/2003	Junaid Ahmed Siddiqui	06354ZP USA	2963

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AIR PRODUCTS AND CHEMICALS, INC.
PATENT DEPARTMENT
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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,527

Applicant(s)

SIDDIQUI, JUNAID AHMED

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/23/06 and 3/17/06 has been entered.

The previous rejections have been withdrawn, in view of applicants remarks, because the instant rejections are more comprehensive to the instant claims. This is apparent because the secondary reference, as now applied, teaches that the claimed surfactant is used in combination with an inorganic abrasive (colloidal silica) to make a polishing composition.

Claims 1, 3-9 and 11-18 are rejected under 35 U.S.C. 103(a) as obvious over Streinz et al. (686) in view of Moeggenborg et al. (762).

Streinz et al. teach in the abstract, column 4, line 25-column 7, line 60, a polishing composition which comprises an abrasive (silica), a fluoride salt (ammonium fluoride) and a surfactant. Example 1 shows that a colloidal abrasive is used. The composition is used to polish substrates that contain dielectrics.

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Moeggenborg et al. teaches in column 6, last three lines of section [0047], that the claimed specific diol is a known (nonionic) surfactant to be used with colloidal abrasive (silica) to make a polishing composition.

The primary reference teaches a composition that contains the claimed components a) and b). With respect to claimed component "c)", the primary reference teaches that a surfactant can be added (surfactant is not limited and can be a nonionic surfactant). The claimed diol is a well known nonionic surfactant (to be used with colloidal abrasive to make a polishing composition), as is clearly shown by the secondary reference and therefore the use thereof is well within the level of ordinary skill in the art because the primary reference implies that any nonionic surfactant can be used. This implication, as defined by the primary reference, provides the necessary motivation for the combination, as applied. The use of any nonionic surfactant is obvious to the skilled artisan, especially known nonionic surfactants, as shown by the secondary reference. Although the primary reference does not literally state that colloidal silica is used, this aspect is obvious because (1) as can be seen from the size of the silica (less than 0.4 microns), it can be colloidal in size, thus reading on colloidal silica and (2) example 1 defines that the abrasive is colloidal. Although the example uses colloidal alumina, it is the examiners position that this example teaches that colloidal abrasive can be used and the skilled artisan would have known that this would also apply to other abrasives (silica) absent evidence to the contrary. The examiner acknowledges that the teaching of the secondary reference is a comparative example, however, since a reference can be used for all it teaches, this surfactant is known, irrespective of it being defined in a comparative example.

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Claims 1, 3-9 and 11-18 are rejected under 35 U.S.C. 103(a) as obvious over Mirsa et al. in view of Moeggenborg et al. (762).

Misra et al. teach in column 3, lines 30-57, column 5, lines 25-40 and column 6, lines 30-35, a polishing composition which comprises an abrasive (colloidal silica), ammonium fluoride and a surfactant. An example of a surfactant is of the SURFYNOL type (i.e. nonionic surfactant). The composition is used to polish substrates that contain dielectrics.

The primary reference teaches a composition that contains the claimed components a) and b). With respect to claimed component "c)", the primary reference teaches that a surfactant can be added (an example of a surfactant is defined and this being a **nonionic** surfactant-SURFYNOL type). The claimed diol is a well known nonionic surfactant (to be used with colloidal abrasive to make a polishing composition), as is clearly shown by the secondary reference and therefore the use thereof is well within the level of ordinary skill in the art because the primary reference implies that any type of SURFYNOL (nonionic surfactants) can be used (i.e. the reference is not limited to the specific nonionic surfactant defined because this is a mere example). This implication, as defined by the primary reference, provides the necessary motivation for the combination, as applied. The use of any nonionic surfactant is obvious to the skilled artisan, especially known SURFYNOL (nonionic) surfactants, as shown by the secondary references. In addition, and assuming *arguendo* about the surfactant defined by the primary reference, the substitution of one known SURFYNOL (nonionic) surfactant for another is well within the level of ordinary skill in the art. In view of this, the use of any nonionic SURFYNOL surfactant is well within the level of ordinary skill in the art. The examiner acknowledges that the teaching of the secondary reference is a comparative example, however,

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since a reference can be used for all it teaches, this surfactant is known, irrespective of it being defined in a comparative example.

Claims 1, 3-9 and 11-18 are rejected under 35 U.S.C. 103(a) as obvious over Pasqualoni et al. (913) in view of Moeggenborg et al. (762).

Pasqualoni et al. teach in column 4, line 29, column 4, line 65-column 5, line 1 and column 5, line 39, a polishing composition which comprises an abrasive (colloidal silica), a fluoride salt (ammonium fluoride) and a surfactant. The composition is used to polish substrates that contain dielectrics (implied by the teaching of column 1, lines 4-5 and column 1, lines 17—19).

The primary reference teaches a composition that contains the claimed components a) and b). With respect to claimed component “c)”, the primary reference teaches that a surfactant can be added (surfactant is not limited and can be a nonionic surfactant). The claimed diol is a well known nonionic surfactant (to be used with colloidal abrasive to make a polishing composition), as is clearly shown by the secondary reference and therefore the use thereof is well within the level of ordinary skill in the art because the primary reference implies that any nonionic surfactant can be used. This implication, as defined by the primary reference, provides the necessary motivation for the combination, as applied. The use of any nonionic surfactant is obvious to the skilled artisan, especially known nonionic surfactants, as shown by the secondary reference. The examiner acknowledges that the teaching of the secondary reference is a comparative example, however, since a reference can be used for all it teaches, this surfactant is known, irrespective of it being defined in a comparative example.

Applicant's arguments with respect to all the claim have been considered but are moot in view of the new ground(s) of rejection.

Applicants declaration filed 2/23/06 has been considered, however, this declaration is not sufficient to overcome the rejection, as now applied because (1) the declaration is not consistent with the rejection as defined above (relates to the previous rejections) and (2) the declaration is not commensurate in scope with the claims.

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. **Evidence of unexpected results must be commensurate in scope with the subject matter claimed.** *In re Linder* 173 USPQ 356. Any evidence of synergism defined in the specification is not commensurate in scope with the new broad claim. In addition, the claimed invention does not show sufficient evidence of unexpected results of the claimed specific surfactant and fluoride/surfactant mixture.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/05
MM

Michael A. Marcheschi
Primary Examiner

